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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Re Patent application of:

Applicant(s): Roger G.M. Lucassen

Serial No: 09/453,480

Filing Date: December 9, 1999

Title: CUSHIONING CONVERSION MACHINE WITH MULTI-PATH PAPER  
THREADING AND CUTTING BLADE SHUTTER

Examiner: Eugene Lee Kim

Art Unit: 3721

Docket No. RANPP0305USA

**REPLY BRIEF**

IN REPLY TO EXAMINER'S ANSWER MAILED SEPTEMBER 30, 2004

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sirs:

In reply to the Examiner's Answer, mailed September 30, 2004, the undersigned submits this brief in triplicate for the Board's consideration of the appeal concerning the final rejection of claims 4-7 and 11-15 of the above-identified application.

## **Reply to Examiner's Answer**

As discussed in the Appeal Brief, the final rejection of the claims should be reversed because the Examiner failed to make a prima facie case for obviousness of the claimed invention. Specifically, the Examiner failed to meet the requirement to identify any teaching or suggestion that would motivate a person of ordinary skill in the art to modify the teachings of the primary reference, Simmons, in the proposed manner to derive the claimed invention.

in the Examiner's Answer, the Examiner repeated the final rejection, and responded to the arguments in the Appeal Brief regarding the lack of motivation by taking the position that:

- (1) only the shearing action is critical,
- (2) the claimed flush shutter is immaterial, and
- (3) the concept of cutting entirely through a workpiece to block the path of the strip of dunnage is within the realm of one of ordinary skill in the art.<sup>1</sup>

The first two positions are contradicted by the record, and the third is irrelevant to the central question of motivation. Thus even if these assertions are correct, they do not overcome the deficiencies in the rejection, and reversal of the rejection is again requested.

With regard to the first item, if only the shearing action is critical in the claimed invention, since Simmons already discloses using a shearing action for cutting a strip of dunnage, the concept of using a shearing action to cut dunnage would not be enough to motivate the ordinary skilled person to look any further than the teachings of

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<sup>1</sup> Examiner's Answer, last paragraph on page 4, through page 5.

Simmons, much less to combine the teachings of Simmons with either Wilhelm or Huston.

Moreover, even though a shearing action was a feature of Simmons's cutting assembly, jamming did occur with such cutting devices. Appellants respectfully submit that more than shearing action is critical to the claimed invention. The shearing action does not address the jamming problem that led to the claimed shutter. The jamming problem is one that Simmons did not appear to recognize or take corrective action to address.

Second, in the claimed shutter, having an upstream surface substantially flush with the upstream surface of the cutting blade is not immaterial. The flush surfaces actually do provide a material benefit. As stated in the present application, a shutter surface that is flush with a surface of the cutting blade is less likely to catch and allows the cut edge of the dunnage strip to easily slide as the cutting blade moves past it in either direction.<sup>2</sup>

Third, and finally, whether the ordinary skilled person had the skill to provide the claimed shutter (i.e., is "within the realm" of one of ordinary skill) is not in dispute -- the issue is whether such a person would have been motivated to do so, and the Examiner still has not made the required case for why such a person would have been motivated to modify Simmons to include the claimed shutter.

To support his position that Simmons suggests blocking the path of the dunnage, the Examiner cites Simmons's FIG. 5B1. When the teachings of Simmons are considered in their entirety, however, it is clear that Simmons does not teach or suggest

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<sup>2</sup>See specification, p. 12, lines 16-21.

the claimed shutter. Simmons discloses a cutting blade 72 but not the claimed shutter. FIG. 5B1, shows the cutting blade 72 at a position that appears to be about halfway through a cut. Although the blade 72 does block the path of the stock material in these figures, the blade 72 has not cut entirely through the workpiece at the point in time illustrated in FIG. 5B1.

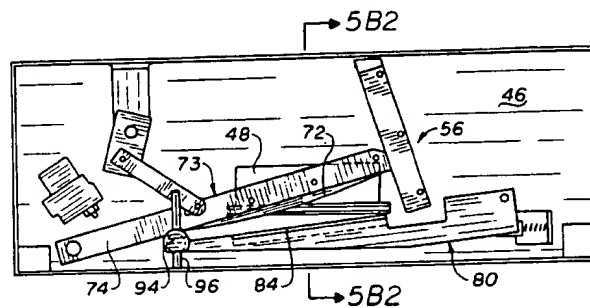


FIG. 5B1

In contrast, FIG. 4 shows the cutting blade at the end of its cutting stroke, where it clearly does not block the path of the strip. From FIG. 4 we can surmise that

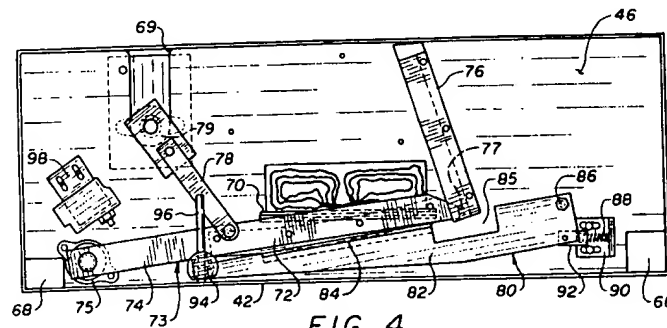


FIG. 4

Simmons assumed that the cut end of the strip would not move, or if it does move, it does not create a problem. As noted in the background portion of the application, however, Appellant recognized that the resilient nature of the dunnage strip had led to the relaxation of the crumpled strip along its longitudinal axis, which allowed the cut end

of the strip to move forward and interfere with the return stroke of the cutting blade.<sup>3</sup>

Not only does Simmons fail to suggest the claimed shutter, but Simmons clearly does not recognize the problem that the shutter addresses.

The secondary references fail to overcome Simmons's deficiencies. Wilhelm, for example, uses a heater in conjunction with the cutting blade to cut a heat sensitive transparent film sheet. As the cutting blade cuts through the heat sensitive sheet, the heat causes the cut edges to shrink away from the blade. Consequently, the ordinary skilled person would not consider the possibility that the cut material could interfere with and jam Wilhelm's cutting blade on a return stroke or that Wilhelm's blade incorporated a shutter that was a desirable feature for preventing jamming or had any other features that would benefit Simmons's cutting blade.

Moreover, considering the teachings of Wilhelm as a whole, it is respectfully submitted that the teachings of Wilhelm do not apply to Simmons's system. Wilhelm appears to teach the advantageousness of using a heater in conjunction with a knife blade to cut a heat sensitive film sheet while simultaneously using heat to seal the sheet to a food container over which the sheet is stretched. The undersigned cannot see how this would motivate an ordinary skilled person to modify Simmons's cushioning conversion machine. Further, Simmons both is critical of plastic packaging materials,<sup>4</sup> and preferably uses kraft paper for conversion into a cushioning product,<sup>5</sup> thus the ordinary skilled person would not even consider applying the teachings of Wilhelm to

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<sup>3</sup>See specification, p. 11, line 23 through p. 12, line 7.

<sup>4</sup>Simmons, col. 1, lines 17-35.

<sup>5</sup>Simmons, col. 4, lines 18-21.

Simmons. Accordingly, Wilhelm also fails to teach or suggest why it would be desirable to include the claimed flush surface for Simmons's cutting blade.

The other secondary reference, Huston, also fails to provide a reason to add a shutter surface that is flush with a surface of the cutting blade. Huston discloses a cutting blade mounted in a forming tool 32 and supported by a shaft 37. The shaft 37 forms a shoulder behind the cutting blade. After the point 42 of the knife pierces the stock material, the forward end of the shaft 37, and the shoulders thereof, continue to advance, forcing the severed ends of the stock material apart at both sides of the cut. The advancing shoulders also bend a tab 43 on each of the severed ends to mechanically lock the material together.<sup>6</sup>

Huston appears to teach away from the claimed flush surface by asserting that a shoulder should be provided for bending back the cut ends after the knife edge has cut the stock material. In other words, Huston does not teach or suggest any reason for modifying Simmons to include the claimed shutter with a surface that is flush with an upstream surface of Simmons's cutting blade. Moreover, even if a person of ordinary skill in the art combined the teachings of Simmons and Huston, the claimed invention would not result because Huston does not teach or suggest the claimed flush surface.

For similar reasons, the method of claim 11 is neither disclosed nor suggested by Huston. Claim 11 positively recites the step of blocking the strip path to prevent movement of a cut end of the strip from moving behind the moving blade. Huston neither discloses nor suggests that blocking the path of the stock material is desirable, thus there is no reason why a person of ordinary skill in the art would modify Simmons in the proposed manner in view of Huston.

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<sup>6</sup>See Huston, col. 7, lines 34-44.

## Conclusion

In view of the foregoing, it is respectfully submitted that the claims are patentable over the applied art and that the final rejection should be reversed.

Respectfully submitted,

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### CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this paper (along with any paper or thing referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: MS Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: November 16, 2004

Kristine A. Webb  
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